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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,893	11/16/2001	Hiromitsu Sugimoto	57454-279	7560

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Washington, DC 20005-3096

EXAMINER

NGUYEN, TUNG X

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplement

Office Action Summary

Application No.

09/987,893

Applicant(s)

SUGIMOTO ET AL.

Examiner

Tung X Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Supplement

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-2, 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Root (u.s.p 6,201,402).

As to claims 1-2, 7, Root discloses in Fig. 1a-d, a substrate testing apparatus comprising: a first rail group (first two of 109 from the bottom) made of a plurality of rails disposed in parallel with each other; a second rail group (first two of 111 from the left) made of a plurality of rails disposed in parallel with each other in a direction that crosses said first rail group (Col. 6, lines 8-10); a plurality of probe units (125) disposed to cover respective intersections of the rails and being movable along the rails, wherein said plurality of probe units each comprise a probing needle to be brought into contact with a surface of the substrate (Col. 5, lines 17-23); and corresponding interval maintaining means (107, 108) for keeping each probe unit corresponding to an arrange of locations to be measured on a substrate (Col. 2, lines 55-68, Col. 3, line 1).

As to claim 3, Root discloses in Fig. 1a-d, the substrate testing apparatus, wherein said corresponding interval maintaining means (107, 108) maintains the interval after changing the interval every time the arrangement of the locations to be measured changes.

As to claim 4, Root discloses in Fig. 1a-d, the substrate testing apparatus, wherein said corresponding interval maintaining means (107, 108) comprises equal interval maintaining means (via 119, 121) for keeping each rail included in said first rail group at an equal interval.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Root (u.s.p. 6,201,402), in view of Ohno et al. (u.s.p 6,384,734).

Claim 5 adds the limitations of the substrate testing apparatus further comprising: displacement measuring means for measuring a displacement of one or more observation points on the substrate subjected to measurement; and displacement measurement value feedback means for setting the interval of each rail, in accordance with a displacement measurement value given by said displacement measuring means. Root does not disclose the above limitations. However, Ohno et al disclose in Fig. 1, a

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system comprising a displacement measuring means (11) for measuring a displacement of one or more observation points on the substrate; and displacement measurement value feedback means (12-14, 16-17) for setting the interval of each rail, in accordance with a displacement measurement value given by said displacement measuring means (Col. 4, lines 8-49). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system of Root, and provide a displacement measuring means, and displacement measurement value feedback means, as taught by Ohno et al., in order to achieve good result from testing.

Allowable Subject Matter

4. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 6 recites, inter alia, the substrate testing apparatus further comprising: temperature measuring means for measuring a temperature; and temperature measurement value feedback means for setting the interval of each, in accordance With a temperature measurement value given by said temperature measuring means.

The art of record does not disclose the above limitations, nor would it be obvious to modify the art of record so as to include the above limitations.

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Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tung X Nguyen whose telephone number is (703) 305-3337. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (703)-308-1233. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**KAMAND CUNEO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800**

TN
October 31, 2002